

### **REMARKS/ARGUMENTS**

Applicant has carefully reviewed and considered the Office Action mailed on December 14, 2005, and the references cited therewith.

No claims are amended, no claims are canceled, and new claims 24-27 are added; as a result, original claims 17-21 and new claims 24-27 are pending in this application.

#### **Filing Date**

Applicants' would like to bring to the Examiner's attention that the USPTO appears to have inadvertently entered the filing date of this application as June 27, 2003. The actual filing date of this application is **March 27, 2003**. A Preliminary Amendment was subsequently filed by the Applicants' on June 27, 2003. Applicants' will request a corrected Filing Receipt by separate communication to correct this at the USPTO.

#### **Double Patenting Rejection**

Claim 17 was rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claim 11 or 12 over of U.S. Patent No. 6,557,992. A Terminal Disclaimer in compliance with 37 CFR 1.321(b)(iv) is enclosed herewith to overcome these rejections.

#### **§103 Rejection of the Claims**

Claims 17-21 were rejected under 35 USC §103(a) as being unpatentable over Spencer, et al. (U.S. Patent No. 6,042,278) in view of Liang, et al. (U.S. Patent No. 5,701,230).

The rejection states in part:

Spencer et al disclose in Figures 1-4 an imaging device such as a print (Figure 1, printers 10, 12, 14), comprising the step of printing decoration (Figure 3, demo images 54, column 2, lines 21-24) on a top surface of a decorative sheet (sheets of paper from printers 10, 12, 14). . . .

The rejection further states in part:

Liang et al teach in Figure 5 the following:

Further regarding claim 17, the decorative sheet (picture or photograph, column 3, lines 12-13) is placed behind the transparent door (transparent lid member 26, column 2, line 60), whereby the decoration (picture or photograph, column 3, lines 12-13) may be viewed through the transparent door (column 3, lines 12-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a transparent door with a decoration behind, as taught by Liang et al into Spencer et al, for the purpose of identifying, enjoyment or convenience (column 3, lines 15-16).

From the Applicant's review of Spencer and Liang, Applicant is unable to locate any description or suggestion of a decorative sheet. That is, Spencer appears to describe a demo page associated with retailing. The demo pages in Spencer may be tailored to a particular model of printer and are selected by a controller. (Col. 2, lines 21-24). Thus, Spencer does not provide a description or suggestion as to printing a "decorative sheet" for inexpensively decorating an "imaging device" to create a customized appearance.

Further, Liang appears to describe a portable computer having a transparent lid member to receive a picture, a photograph, a disk or the like for purposes of identifying, enjoyment, and convenience. Liang, too, does not provide a description or suggestion as to a printing a "decorative sheet" for inexpensively decorating an imaging device to create a customized appearance.

In contrast, Applicant's claim 17 recites "printing decoration on a top surface of a decorative sheet using an imaging device and placing the decorative sheet behind the transparent door on the imaging device". Applicant respectfully submits that printing a decorative sheet, as claimed, is different from the demo pages of Spencer and the picture, photograph or disk described in Liang. Moreover, there is no teaching or suggestion in Spencer to create decorative sheets that personalize an imaging device for an end user. And, there is no teaching or suggestion from within Liang to provide an imaging device which generates a decorative sheet that can then be applied to the imaging device. Liang, is designed to receive an article generated from an entirely different source. The portable computer is neither a printer, camera, or disk creation device.

As described in the Applicant's specification, the claimed embodiments allow a user to inexpensively decorate an imaging device to create a customized appearance. According to the claimed invention, a user may design a custom

decoration and print that decoration on the a decorative sheet with the imaging device. (Spec. page 5, paragraphs [20], [21], and [22].

In view of these remarks, Applicant respectfully submits that neither Spencer nor Liang describe, teach or suggest, either independently or in combination, an imaging device to print and receive a "decorative sheet". As such, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection for independent claim 17, as well as those claims which depend therefrom.

#### New Claims

Applicant respectfully submits new claims 24-27. Claims 24-27 do not introduce new matter and are fully supported by the Applicant's specification as originally filed. New claims 24-27 are intended only to capture additional allowable subject as enabled by the present application. Consideration for the same is requested upon review of the present response.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Charles F. Moore, at (360) 212-8369 to facilitate prosecution of this matter.

At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AMENDMENT Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 31<sup>st</sup> day of March, 2005.

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Date: 3/31/2005